



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/215,569	12/16/1998	ETHAN BIER	07349/019001	7230

7590 01/22/2002

FOLEY AND LARDNER  
402 WEST BROADWAY  
23RD FLOOR  
SAN DIEGO, CA 92101-3542

EXAMINER

ROMEO, DAVID S

ART UNIT	PAPER NUMBER
----------	--------------

1647

DATE MAILED: 01/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/215,569

Applicant(s)

BIER ET AL.

Examiner

David S Romeo

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 3-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 1647

1. The amendment filed 01/11/2002 (Paper No. 16) has been entered in part. The amendment to claim 1 has been entered. The substitute specification filed 01/11/2002 has not been entered because it does not conform to 37 CFR 1.125(b) because: it lacks a marked up version of the substitute specification showing all the changes (including the matter being added to and the matter being deleted from) to the specification of record. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.
2. Claims 1-26 are pending. Claims 3-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 14. Claims 1 and 2 are being examined. Any objection and/or rejection of record that is not maintained and/or repeated in this Office action is withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The application is not fully in compliance with the sequence rules, 37 C.F.R. § 1.821-1.825. Specifically, 37 C.F.R. § 1.821 (d) which states "Where the description or claims of a patent application discuss a sequence that is set forth in the "Sequence Listing" in accordance with paragraph (c) of this section, reference must be made to the sequence by use of the sequence identifier, preceded by "SEQ ID NO: " in the text of the description or claims." The application references sequences by use of the sequence identifier, preceded by "SEQ.ID.No.". "SEQ.ID.No." should be "SEQ ID NO: ". Correction is required. It is acknowledged that "all of the "SEQ.ID.NO." have been changed to "SEQ ID NO:" in the substitute specification filed 01/11/2002. However, the substitute specification has not been entered. Applicants argue that

Art Unit: 1647

there is no requirement that the sequence identifiers be presented in any particular format.

Applicants arguments have been fully considered but they are not persuasive. 37 C.F.R. § 1.821

(d) states 'reference must be made to the sequence by use of the sequence identifier, preceded by "SEQ ID NO:" in the text of the description.' Nowhere does it state that other formats are acceptable or that Applicants are free to devise there own format.

4. The amendment filed 12/22/2000 (Paper No. 11, the response to the notice to comply) is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. Applicants argue that Paper No. 11 is fully supported by the original disclosure, the nucleotide and amino acid sequence of wild-type Sog are known in the art, and the nucleotide and amino acid sequences of SuperSog are identified at page 6, line 16, through page 7, line 5. Applicants arguments have been fully considered but they are not persuasive. The figures in the original disclosure, including the nucleotide and amino acid sequences encompassing CR1 repeats, are illegible, unreadable, and indecipherable and there is no basis in the original disclosure for the sequences in the paper copy and computer readable form of the sequence listing. A reference incorporated by reference may possibly provide a basis for importing the sequences in the paper copy and computer readable form of the sequence listing into the disclosure but the present application does not incorporate Francois et al. (page 5, lines 6-11) by reference. The examiner cannot identify the sequences of the paper copy and computer readable form of the sequence listing in the present specification at page 6, line 16, through page 7, line 5.

**New formal matters, objections, and/or rejections:**

***Claim Rejections - 35 USC § 112***

Art Unit: 1647

5. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Support for the limitation "synthetic" cannot be found in the specification or claims as originally filed and the introduction of such a limitation raises the issue of new matter.

6. The amendment filed 01/11/2002 (Paper No. 16) is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the formal drawings are not supported by the original disclosure because the sequences in the figures in the original disclosure are illegible, unreadable, and indecipherable and there is no basis in the original disclosure for the sequences in the formal drawings.

### ***Conclusion***

7. Claim 2 is objected to as being dependent upon a rejected base claim.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 1647

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO DAVID S. ROMEO WHOSE TELEPHONE NUMBER IS (703) 305-4050. THE EXAMINER CAN NORMALLY BE REACHED ON MONDAY THROUGH FRIDAY FROM 7:30 A.M. TO 4:00 P.M.

IF ATTEMPTS TO REACH THE EXAMINER BY TELEPHONE ARE UNSUCCESSFUL, THE EXAMINER'S SUPERVISOR, GARY KUNZ, CAN BE REACHED ON (703) 308-4623.

IF SUBMITTING OFFICIAL CORRESPONDENCE BY FAX, APPLICANTS ARE ENCOURAGED TO SUBMIT OFFICIAL CORRESPONDENCE TO THE FOLLOWING TC 1600 BEFORE AND AFTER FINAL RIGHTFAX NUMBERS:

BEFORE FINAL (703) 872-9306

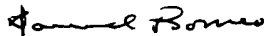
AFTER FINAL (703) 872-9307

IN ADDITION TO THE OFFICIAL RIGHTFAX NUMBERS ABOVE, THE TC 1600 FAX CENTER HAS THE FOLLOWING OFFICIAL FAX NUMBERS: (703) 305-3592, (703) 308-4242 AND (703) 305-3014.

CUSTOMERS ARE ALSO ADVISED TO USE CERTIFICATE OF FACSIMILE PROCEDURES WHEN SUBMITTING A REPLY TO A NON-FINAL OR FINAL OFFICE ACTION BY FACSIMILE (SEE 37 CFR 1.6 AND 1.8).

FAXED DRAFT OR INFORMAL COMMUNICATIONS SHOULD BE DIRECTED TO THE EXAMINER AT (703) 308-0294.

ANY INQUIRY OF A GENERAL NATURE OR RELATING TO THE STATUS OF THIS APPLICATION OR PROCEEDING SHOULD BE DIRECTED TO THE GROUP RECEPTIONIST WHOSE TELEPHONE NUMBER IS (703) 308-0196.



DAVID ROMEO  
PRIMARY EXAMINER  
ART UNIT 1647

DSR

January 22, 2002